

## REMARKS

### I. INTRODUCTION

In response to the Office Action dated March 8, 2004, Applicants request that claims 2, 5, 6, 12, 14, 31, 32, 35, 36 and 38 be canceled, and that claims 1, 7, 16, 26, 27, 37, 39 and 43 be amended. Claims 1, 3, 4, 7-11, 13, 15-17, 26, 27, 30, 33, 34, 37, and 39-54 remain in the application. Entry of these amendments, and reconsideration of the application, as amended, is requested.

### II. CLAIM AMENDMENTS

Applicants' attorney has made amendments to the claims as indicated above. These amendments were made solely for the purpose of clarifying the language of the claims, and do not introduce new matter.

Claims 1, 7, 37, 39 and 43 have been amended to recite specific immunologically significant epitopes of HSV UL49 identified in the application, including amino acids 105-126, 125-146, 187-206, which are described in Figures 3A-C of the application as originally filed. Reference to non-elected subject matter has been deleted from these claims.

Claim 16 has been amended to update the reference to claim 15, in view of the cancellation of claim 14.

Claims 26 and 27 have been amended to delete the redundant language "or preventing", given the intended meaning here as "hindering or delaying progression of", which is encompassed within "treating".

Claim 27 has been amended to update the reference to claim 13, in view of the cancellation of claim 2.

Entry of these amendments is respectfully requested.

### III. ALLOWABLE SUBJECT MATTER

Applicants gratefully acknowledge the Examiner's indication at page 6 of the Office Action that claims 43-54 would be allowable if limited to the elected UL49 product, subject to resolution of double patenting issues. Applicants have amended claims 43-54, to limit their subject matter in

accordance with the Examiner's suggestion. In addition, the remaining claims have been amended similarly to place them in condition for allowance. Should the Examiner believe that these new and amended claims cannot be allowed without significant additional effort, Applicants respectfully request the Examiner contact the undersigned representative at the telephone number below for clarification.

#### IV. ELECTION/RESTRICTION

Applicants gratefully acknowledge the Examiner's rejoinder of claims relating to U<sub>1</sub>49 polypeptide and its corresponding nucleic acid, as indicated at page 2 of the Office Action. Applicants have amended the claims to delete reference to non-elected epitopes of HSV.

#### V. DOUBLE PATENTING

At pages 2-3 of the Office Action, the Examiner provisionally rejected claims 1-17, 26, 27, and 30-54 under the judicially created doctrine of obviousness-type double patenting over claims 1-32 of co-pending application number 10/210,428. Applicants expect that the claims of both the instant application and co-pending application number 10/210,428 will be amended in such a manner that they will be patentably distinct from each other. Accordingly, Applicants will postpone submission of a terminal disclaimer until final determination of the claims to be allowed in these applications. Should a terminal disclaimer be deemed necessary at that time, however, Applicants will provide an appropriate terminal disclaimer.

#### VI. REJECTIONS NOT BASED ON THE PRIOR ART

At page 3 of the Office Action, claims 7-11, 13, 15 and 33 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for using both open and closed language. Applicants have amended claim 7 to delete the "comprising" language.

At pages 3-4 of the Office Action, claims 26 and 27 were rejected under 35 U.S.C. 112, first paragraph, as not supported by an enabling disclosure for a method of preventing HSV infection. Applicants have amended claims 26 and 27 to obviate this rejection.

## VII. REJECTIONS BASED ON THE PRIOR ART

At pages 4-5 of the Office Action, claims 1-17 and 30-42 were rejected under 35 U.S.C. 102(e), as anticipated by Burke et al., U.S. Patent No. 6,635,258. The amendments to the claims renders this rejection moot.

At pages 5-6 of the Office Action, claims 26 and 27 were rejected under 35 U.S.C. 103(a), as unpatentable over Burke et al., U.S. Patent No. 6,635,258. The amendments to the claims renders this rejection moot.

## VIII. CONCLUSION

In view of the above, it is submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicants' undersigned attorney.

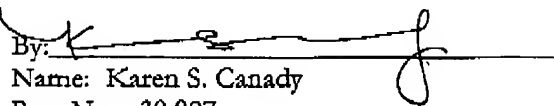
Respectfully submitted,

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